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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-YVES CHENARD and JEAN-CLAUDE MENDELSON

Appeal No. 95-1963
Application No. 07/870,759¹

HEARD: February 12, 1999

Before KIMLIN, OWENS and SPIEGEL, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233 and

¹ Application for patent filed April 20, 1992. According to appellants, this application is a continuation of Application No. 07/633,187, filed December 28, 1990; which is a continuation of Application No. 07/273,669, filed November 18, 1988; which is a continuation of Application No. 06/254,313, filed April 15, 1981; which is a continuation-in-part of Application No. 06/070,503, filed August 28, 1979; all abandoned.

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237-323, all the claims remaining in the present application.

Claims 247 and 296 are illustrative:

247. A composition comprising a product produced by mixing in amounts effective to stabilize vinyl halide resins:

(i) a mono- or diorganotin compound wherein at least one atom bonded to tin is sulfur; and

(ii) a mercapto alkanol ester of a monocarboxylic acid.

296. A composition comprising a product produced by mixing in amounts effective to stabilize vinyl halide resins:

(i) a mono- or diorganotin compound wherein at least one atom bonded to tin is a halogen; and

(ii) a mercapto alkanol ester of a monocarboxylic acid.

In the rejection of the appealed claims, the examiner relies upon the following references:

Weinberg (Weinberg '750)	2,832,750	Apr. 29, 1958
Hechenbleiker et al.	3,167,527	Jan. 26, 1965
(Hechenbleiker '527)		
Hechenbleiker et al.	3,196,129	Jul. 20, 1965
(Hechenbleiker '129)		
Schroeder	3,595,893	Jul. 27, 1971
Wowk	3,758,537	Sep. 11, 1973
Kauder (Kauder '915)	3,817,915	Jun. 18, 1974
Stapfer	3,830,751	Aug. 20, 1974
Gough et al. (Gough)	3,928,285	Dec. 23, 1975
Kugele et al. (Kugele '619)	4,360,619	Nov. 23, 1982
Bresser et al. (Bresser '984)	4,576,984	Mar. 18, 1986
Kugele et al. (Kugele '114)	4,665,114	May 12, 1987
Bresser et al. (Bresser '486)	B1 4,701,486	May 19, 1992
		(filed Jan. 5, 1984)
Ito et al. (Japanese '336)	56-2336	Jan. 12, 1981
(Japanese Kokai patent application)		

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Ito et al. (Japanese '044) 55-160044 Dec. 12, 1980
(Japanese Kokai patent application)

Appellants' claimed invention is directed to a composition comprising a mixture of (1) a mono- or diorganotin compound wherein at least one atom bonded to tin is sulfur (claim 247) or a halogen (claim 296) and (2) a mercapto alkanol ester of a monocarboxylic acid. The claimed compositions find utility as additives to halogeno-vinyl resins, such as polyvinyl chloride, for the purpose of imparting stabilization to the resins. According to appellants, the mono- or diorganotin compounds are conventional stabilizers for polyvinyl chloride, and the present invention resides in combining such conventional stabilizers with alkyl organic esters containing a mercapto group in the alcohol residue of the ester.

Appellants submit two separate groups of claims for separate consideration (see pages 8 and 9 of Brief). According to appellants' grouping, claims 193-198, 200-207, 209-217, 219-225, 227-233 and 237-295 stand or fall together with claim 247. Also, claims 176-183 and 296-323 stand or fall together with claim 296. We will adopt appellants' terminology and refer to the composition of claim 247 as comprising "sulfur-containing tin stabilizers" and to the composition of claim 296 as comprising "halogen-containing tin stabilizers."

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The present application, through a series of continuing applications, is a continuation-in-part of U.S. Application No. 06/070,503, filed August 28, 1979 (original application). Appellants took an appeal in the first continuation-in-part of the original application (Application No. 06/254,313, filed April 15, 1981). In a decision dated June 25, 1987 (Appeal No. 660-84), the Board affirmed the examiner's rejections and entered new grounds of rejection under the provisions of 37 CFR § 1.196(b). The Board agreed with the examiner that the appealed claims of the continuation-in-part application did not have descriptive support within the meaning of 35 U.S.C. § 112, first paragraph, in the original application. The appealed claims now before us are of considerably different scope than the appealed claims before the Board in the prior appeal. For instance, whereas the organotin stabilizer in the prior appeal defined the remaining valences of the tin atom as satisfied by bonds to halogen, oxygen, phosphorus, sulfur and a residue resulting from, inter alia, the removal of the hydrogen atom from the oxygen atom of a carboxylic acid and the removal of the hydrogen atom from the sulfur atom of a mercaptan, the claims now on appeal recite that the organotin stabilizer has at least one halogen or one sulfur atom bonded to the tin.

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The appealed claims stand rejected under 35 U.S.C. § 102(a) as follows:

(1) claims 176-183, 193-198, 209-217, 219-225, 227-233 and 237-323 over Japanese '044 and Japanese '336;

(2) claims 176, 183, 237-246, 247-254, 261-272, 279-287 and 295 over Kugele;

(3) claims 193, 198 and 237-295 over Bresser '984; and

(4) claims 193-198 and 237-295 over Bresser '486.

In addition, claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233 and 237-323 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gough in view of Stapfer, Hechenbleiker '129 and '527, Wowk, Schroeder, Weinberg '750 and Kauder '915.

We consider first the § 102 rejections of the appealed claims over the five separately applied references. Appellants concede that if there was not descriptive support in the original application for the appealed claims, i.e., if they are not entitled to rely on the filing date of the original application, August 28, 1979, then they will not challenge the § 102 rejections (see footnote at page 8 of Brief). Accordingly, a dispositive issue on appeal is whether the appealed claims find descriptive support in the original application.

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Regarding the appealed claims directed to the tin compounds containing sulfur, we fully concur with appellants that the original application provides descriptive support for such. To wit, the examiner does not dispute that EXAMPLES 3, 4, 7 and 8 of the original application demonstrate the use of an organotin stabilizer wherein at least one of the atoms bonded to tin is sulfur. Rather, it is the examiner's position that the disclosure of the original application "is not tantamount to encompassing all and any known organotin stabilizers at that time much less those having Sn-S bonds" (page 6 of Answer). Accordingly, it can be seen that the examiner's rejection is based on the enablement requirement of § 112, first paragraph, not the descriptive requirement. However, the examiner has the initial burden of establishing lack of enablement by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). In the present case, the examiner has provided no compelling reasoning or objective evidence that one of ordinary skill in the art would be unable to practice the claimed invention in view of the disclosure in the original application. Accordingly, we will not

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sustain the examiner's § 102 rejections of appealed claims 193-198, 200-207, 209-217, 219-225, 227-233 and 237-295.

The § 102 rejections of appealed claims 176-183 and 296-323 (the tin compounds containing halogen claims) is another matter. As acknowledged at page 17 of appellants' Brief, "[a]ppellants readily concede that support for halogen-containing tin compounds in the original application becomes a bit more problematical." There is no dispute that the original application does not provide literal support for halogen-containing tin compounds. Appellants contend that implicit support for halogen-containing tin compounds is found at page 6 of the original specification, lines 20-24, wherein it is disclosed that "salts of tin not containing sulfur" can be used as stabilizers. According to appellants, "[h]alogen-tin compounds were well-known compounds at the time of the original application and fall within the scope of the well-known mono- and di-organic tin compounds contemplated by the inventors," and that "[o]ne of ordinary skill in the art would know that halogen-containing tin compounds were among those being described in the original specification" (page 18 of Brief, first paragraph). Appellants rely upon four U.S. patents and a British patent cited in the Supplemental Declaration of N. Foure, filed August 9, 1984, as evidence that "organotin halides were

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well[-]known conventional compounds which would fall within the scope of the Appellants' claims" (page 18 of Brief).

In accordance with current patent jurisprudence, the description requirement of 35 U.S.C. § 112 requires that the original disclosure reasonably conveys to one of ordinary skill in the art that the inventors had in their possession, as of the filing date of the application, the later added claim limitation. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1561-62, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Here, the issue is whether the disclosure of the original application reasonably conveys to one of ordinary skill in the art stabilizing tin compounds containing halogen.

As stated in Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1115, the description and enablement requirements of 35 U.S.C. § 112, first paragraph, are separate considerations, and while a specification may enable the practice of a broadly claimed invention, it still may not describe that invention. The "invention" referred to in the § 112 language "written description of the invention" is "*whatever is now claimed.*" Vas-Cath, 935 F.2d at 1564, 19 USPQ2d at 1117.

What is now claimed is halogen-containing tin derivatives, and we agree with the examiner that the original application does

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not convey to one of ordinary skill in the art that appellants had in their possession at the time of filing the original application the invention of employing halogen-containing tin derivatives as stabilizers in conjunction with a mercapto alkanol ester of a monocarboxylic acid. In our view, the patents cited in the Supplemental Declaration of N. Foure go more to demonstrating that the original application would enable one of ordinary skill in the art to practice the claimed invention utilizing halogen-containing tin derivatives. While we appreciate that the determination of descriptive support is particularly fact specific, we invite appellants' attention to the holding in In re Ahlbrecht, 435 F.2d 908, 911, 168 USPQ 293, 296 (CCPA 1971), wherein the court found that the original disclosure of esters having 3-12 methylene groups did not describe the later-claimed esters having 2-12 methylene groups.

We were asked by appellants' counsel at oral hearing to consider the holding in In re Alton, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996). The court held in Alton that the probative value of a declaration by one of ordinary skill in the art must be weighed in determining whether an original disclosure described a claimed invention. Upon review of the Alton decision, we find that the declaration evidence submitted by

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appellants is not of the same weight as the declaration submitted in the Alton case, where the declarant provided a detailed factual analysis and explanation why one of ordinary skill in the art would have understood the original disclosure to describe the claimed human gamma interferon analog. In the present case, the declaration evidence, considered in a light most favorable to appellants, simply demonstrates that one of ordinary skill in the art would have been enabled by the present specification to utilize halogen-containing tin compounds as stabilizers for halogenated polyvinyl resins. For instance, the Rakita and Larkin Declarations provide the opinion that the skilled artisan would know that halogen-containing organotin stabilizers can be used with mercapto esters. The fact that one of ordinary skill in the art would recognize that halogen-containing organotin stabilizers can be used is supportive of the enabling quality of the original application, but not its descriptive nature. Unlike in Alton, the declarations provide no factual analysis to support the conclusion that one of ordinary skill in the art would understand that the original application conveys that appellants had halogen-containing tin stabilizers in their possession as of the filing date of the application. Also, the separate Declarations of co-inventors Mendelsohn and Chenard, which state

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"[o]ur conception of the scope of our invention included the obvious and well-known halogen-substituted organotin stabilizers," (page 2 of Declarations) are irrelevant to the issue of what the original application conveys to one of ordinary skill in the art.

Accordingly, we find that appellants are not entitled to the filing date of their original application with respect to the halogen-containing claims 176-183 and 296-323. Our finding does not, however, resolve the issue of the propriety of the examiner's rejections under 35 U.S.C. § 102. This is so because appellants rely upon Rule 131 Declarations to show reduction to practice of the subject matter of the halogen-containing claims prior to the effective dates of the applied references.

There is no doubt that the Four 131 Declarations, executed December 19, 1983 and July 13, 1984, demonstrate a reduction to practice of the claimed halogen-containing stabilizers before the effective dates of the applied references. In the Board's decision in the prior appeal, the Four declarations were found to be ineffective to antedate the Japanese references because the declarations showed only a part of what the Japanese references show in terms of halogen-containing stabilizers. Notwithstanding that appellants' declarations do not show a reduction to practice

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of all the halogen-containing stabilizers disclosed by the Japanese references, appellants properly maintain that they "are entitled to the present claims under the principles of In re Spiller, 500 F.2d 1170, 182 USPQ 614 [CCPA 1974], because variations and adaptations of what is shown in the Foure Affidavit would have been obvious to one of ordinary skill in the art at the time of the original application" (page 23 of Brief). To support their argument that the halogen-containing stabilizers disclosed by the Japanese references, but not shown to be reduced to practice in the Foure Declarations, would have been obvious variants of the compounds used in the declarations, appellants rely upon the teachings of U.S. Patent Nos. 3,630,992, 3,758,536, 3,665,025 and British Patent No. 1,117,652. The examiner, on the other hand, seems to rely exclusively on the reasoning set forth in the prior Board decision which, in the face of appellants' arguments and evidence, no longer applies. The examiner has set forth no rationale why the patents cited at page 25 of appellants' Brief would not have rendered obvious the halogen-containing stabilizers disclosed in the Japanese references. In the absence of such rationale, we find that appellants have effectively antedated the references applied by the examiner

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under 35 U.S.C. § 102. Consequently, we will not sustain the examiner's § 102 rejections of claims 176-183 and 296-323.

We now turn to the examiner's § 103 rejection of all the appealed claims over Gough in view of Stapfer, Hechenbleiker '129 and '527, Wowk, Schroeder, Weinberg '750 and Kauder '915. Appellants acknowledge that Gough discloses the use of a mercapto alkanol ester of a monocarboxylic acid within the scope of the appealed claims in conjunction with an organotin compound in order to stabilize vinyl halide resins. Hence, Gough discloses that which appellants characterize as their discovery, viz., "that a different additive--with its sulfur atom bonded not at the acid part of the monocarboxylic acid but at the alcohol part of that compound--dramatically improved the performance of tin stabilizers used for stabilizers polymers" (page 4 of Brief). However, Gough's stabilizing composition comprises an organotin borate rather than the presently claimed organotin compounds wherein the tin is bonded to at least one halogen or sulfur. This lack of disclosure in Gough does not, in our view, negate the conclusion of obviousness reached by the examiner. Based on the collective teachings of Gough, including the discussion in the BACKGROUND section that it was known in the art to employ synergistic combinations of organic thiols and organotin

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mercaptides as stabilizers for vinyl halide polymers, and the applied secondary references, we fully agree with the examiner that one of ordinary skill in the art would have found it prima facie obvious to utilize a combination of a mercapto alkanol ester of a monocarboxylic acid and organotin compounds within the scope of the appealed claims as a stabilizer for a vinyl halide resin. We note that Stapfer provides a further teaching that it was known in the art that a combination of organotin mercaptides and organic thiols provides a synergistic stabilization of vinyl halide resins (column 3, lines 16-19).

Appellants concede that they "always maintained that the organotin compounds used in the claimed invention were well known in the art" (page 30 of Brief), but appellants contend that there would have been no motivation for one of ordinary skill in the art to substitute the claimed, conventional organotin compounds for the organotin borates of Gough and thereby not achieve the disclosed synergistic result. However, it is our view that one of ordinary skill in the art would have understood that the synergistic combination of Gough is superior to other known combinations of stabilizers, and that other combinations of appellants' organotin compounds and a mercapto alkanol ester of a monocarboxylic acid are effective, if not equivalent, stabilizers

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for vinyl halide resins. We find it noteworthy that appellants state that "[t]he prior art supports the Appellants' position that organotin halides were well known conventional compounds which would fall within the scope of the Appellants' claims" (page 18 of Brief). Inasmuch as absolute predictability is not a requirement for a finding of obviousness under 35 U.S.C. § 103, we find that one of ordinary skill in the art would have had a reasonable expectation of successfully stabilizing a vinyl halide resin with a combination of appellants' mercapto alkanol ester of a monocarboxylic acid, disclosed by Gough, and a conventional organotin stabilizer.

Appellants rely upon the Rule 132 Declaration of Foure, executed August 18, 1982, as evidence of nonobviousness for the purpose of rebutting any prima facie case of obviousness.

However, appellants have not met their burden of explaining the content and significance of the declaration data. In re Borkowski, 505 F.2d 713, 719, 184 USPQ 29, 33 (CCPA 1974).

Appellants have devoted a scant two sentences to the merits of the Rule 132 Declaration at page 35 of the Brief, submitting that the declaration provides "a number of comparisons of compositions of the present invention with those of Gough and Stapfer." Also, the declaration does not provide a comparison with the closest

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prior art. In re Johnson, 747 F.2d 1456, 1461, 223 USPQ 1260, 1263-64 (Fed. Cir. 1984). In particular, the declaration fails to compare stabilizer compositions within the scope of the appealed claims and those of Gough comprising appellants' mercapto alkanol ester and an organotin borate. Furthermore, we find that the probative value of the declaration data is hardly commensurate in scope with the degree of protection sought by the appealed claims. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983). In our view, the declaration evidence is insufficient to factually establish that the broadly claimed halogen-containing and sulfur-containing stabilizers, as a class, in composition with the broadly claimed mercapto alkanol ester of a monocarboxylic acid, as a class, are unexpectedly superior to the class of synergistic combinations disclosed by Gough and the prior art. In re Landgraf, 436 F.2d 1046, 1050, 168 USPQ 595, 597 (CCPA 1971).

In conclusion, the examiner's rejections under 35 U.S.C. § 102 are reversed. The examiner's rejection of the appealed claims under 35 U.S.C. § 103 is sustained. Accordingly, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


EDWARD C. KIMLIN
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
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